REMARKS

A check for $790 for the fee for filing of a Request for Continued Examination (RCE) accompanies this response. Any fees that may be due in connection with this application throughout its pendency may be charged to Deposit Account No. 06-1050. An Information Disclosure Statement (IDS) is submitted herewith. Included in the IDS are co-owned U.S. Patent Application Ser. Nos. 10/684,227 and 10/684,229.

Claims 1-25 and 41-55 are pending. Claims 1, 5, 9-11, 15, 19, 23 and 24 are amended herein. Claims 1 and 15 are amended to recite "pharmaceutically acceptable salt or prodrug thereof" in the last line of each claim. Specific basis is found in original claims 1 and 15. Claims 5, 9-11, 19, 23 and 24 are amended to correct minor typographical or formatting errors.

New claims 41-55 correspond to original claims 26-40. As discussed below, new claims 41-55 are added to reserve applicant's right to petition for rejoinder should a product claim be found allowable. No new matter is added. Because added claims 41-55 correspond to original claims 26-40, which were cancelled by Examiner's amendment, no excess claim fees should be due.

Restriction Requirement

The original claims were subject to a Restriction Requirement in the first Office Action, setting forth two groups as follows:

I. Claims 1-25, directed to compounds of formulae I an II and pharmaceutical compositions including these compounds; and

II. Claims 26-40, directed to methods of using compounds of formulae I or II.

Applicant affirms election, with traverse, of Group I, claims 1-25, directed to compounds of formula I and II, for prosecution on the merits. Claims 26-40 were withdrawn from consideration and were cancelled by Examiner's Amendment as directed to non-elected subject matter. Claims 41-55, which correspond to original claims 26-40, are added herein to reserve applicant's right to petition for rejoinder. This application as originally filed included claims directed to products and methods of using the products. Because the applicant elected Group I, drawn to claims directed to the products, for prosecution on the merits, if a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim may be rejoined (see MPEP § 821.04 Rejoinder). Should any of the product claims be deemed allowable, applicant respectfully requests reconsideration of the requirement for restriction and rejoinder of the subject matter of claims 41-55 with the elected subject matter of claims 1-25.

The Recitation "Prodrug" in Claims 1 and 15

Claims 1 and 15 are amended herein to include as subject matter prodrugs of the claimed compounds as originally claimed. Applicant respectfully submits that the recitation of "prodrug" in claims 1 and 15 is in accord with the requirements of 35 U.S.C. § 112, first paragraph. Applicant respectfully submits that a patent application satisfies the requirements of 35 U.S.C. § 112, first paragraph, as long as it provides sufficient disclosure, either through illustrative examples or terminology, to teach those of skill in the art how to make and use the claimed subject matter without undue experimentation. Applicant respectfully submits that the art at the time of filing was replete with guidance for preparing and using prodrugs. See e.g., Richard B. Silverman, *The Organic Chemistry of Drug Design and Drug Action*, Academic Press, Inc., (1992); Chapter 8: "Prodrugs and Drug Delivery Systems," pp 352-401 (a copy is included with the accompanying IDS references). Silverman teaches various types of prodrugs and mechanisms of prodrug activation for compounds that include cyclic, bicyclic, tricyclic and multi-ring drugs. Silverman also teaches use of prodrugs for increasing solubility, adsoprtion and distribution, improving instability *in vivo*, prolonged release, minimizing toxicity, and improving formulation and patient acceptability. A patent application need not teach what is well known in the art. *Spectra-Physics, Inc. v. Coherent , Inc.*, 3 USPQ2d 1737 (Fed. Cir. 1987).

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In view of the above, reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,

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